

27. (Amended) A method of operating an engine valve lash adjuster in an internal combustion engine comprising the steps of:

determining that an engine is operating in a positive power mode;

supplying hydraulic fluid to a lash adjuster in response to a determination that the engine is operating in a positive power mode of operation;

determining that the engine is operating in an engine braking mode; and

venting hydraulic fluid from the lash adjuster in response to a determination that the engine is operating in an engine braking mode of operation.

#### REMARKS

Claims 1-50 are pending in this application. By this Amendment, Claims 22 and 27 are amended. Applicants respectfully request reconsideration of the rejections in view of the following remarks.

##### I. Formal Drawings Are Submitted

Applicants acknowledge with appreciation the approval of the proposed drawing corrections and/or the proposed substitute sheets of drawings filed on December 13, 2001. Formal drawings depicting Figures 1-21 are submitted herewith.

##### II. The Application Complies With 37 CFR 1.172(a)

The application was objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. Applicants respectfully submit that the ownership interest in U.S. Patent No. 6,000,374

was properly established in the papers submitted with the reissue Application on December 13, 2001.

Although the assignment recordation form cover sheet lists Diesel Engine Retarders as assignee, the original assignment document executed by the present inventors accurately assigns the ownership interest to Jacobs Vehicle Systems ("Jacobs"). As such, the Consent of Assignee Under 37 CFR 1.172 executed by Brian Burnett, President of Jacobs, is an appropriate paper satisfying the requirements of 37 CFR 3.73. Accordingly, Applicants respectfully submit that the present reissue application complies with 37 CFR 1.172(a) and request reconsideration and withdrawal of the objection.

**III. The Reissue Oath and Declaration Complies with 37 CFR 1.175**

Claims 1-50 were rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 and 37 CFR 1.175 because it failed to identify at least one error which is relied upon to support the reissue application. This rejection is traversed.

Applicants respectfully submit that the Reissue Oath and Declaration filed on December 13, 2001 complies with 35 U.S.C. 251 and 37 CFR 1.175. In particular, pursuant to 37 CFR 1.175(a)(1), Paragraph 5 of the original Oath and Declaration states that "original U.S. Patent No. 6,000,374 is partly inoperative by reason of the original patent claiming less than I had a right to claim in the patent...the features of newly added Claims 22-50 were inadvertently not incorporated into the Claims of the original patent." In addition, Paragraph 6 of the original Oath and Declaration states that "U.S. Patent No. 6,000,374 is partly inoperative by reason of a defective specification and

drawings...the amendments to the specification and drawings as outlined in the attached Preliminary Amendment and Request for Approval of Drawing Corrections are necessary to correct errors inadvertently incorporated into the original patent.” See 37 CFR 1.175(a)(1). Accordingly, Applicant has identified the errors which are relied upon to support the present reissue application. Reconsideration and withdrawal of the rejection are respectfully requested.

**IV. The Reissue Claims Have Proper Scope Under 35 U.S.C. 251**

Claims 22-50 were rejected under 35 U.S.C. 251 as being an alleged improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. This rejection is respectfully traversed.

Analysis under the recapture rule is a two step process. The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the original patent claims. See *In re Clement*, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997). A reissue claim which includes subject matter not covered by the original patent claims may be considered a broadened claim. See M.P.E.P. § 1412.03. The second step in applying the recapture rule is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. See *Clement*, 131 F.3d at 1468-69. In order to satisfy this second step, the record of the original application must show that the broadening aspect relates to subject matter that applicant previously surrendered. See M.P.E.P. § 1412.02.

Assuming, *arguendo*, the reissue claims in the present application, Claims 22-50, are broader in scope than the original patent claims, the broadening aspects of the

reissue Claims do not relate to any subject matter surrendered during prosecution of the original patent. In the latest Office Action, the Examiner cites an amendment received on 19 May 1999 in the original patent application which added language to independent claims 1 and 23 (which became patented claim 19). The language added to original claim 1 is "wherein said braking means accomplishes at least two braking operations for the at least one exhaust valve per engine cycle during the engine braking operation, wherein said intake valve operating means delays the operation of the at least one intake valve during the engine braking operation." In claim 23, the language added by amendment is (as underlined below):

performing a first compression release event, wherein said first compression release event includes the steps of opening at least one exhaust valve to effectuate engine braking and closing the at least one exhaust valve after predetermined time, wherein said step of opening the at least one exhaust valve to effectuate engine braking during said first compression release event is initiated prior to compression top dead center;

performing a second compression release event, wherein said second compression release event includes opening the at least one exhaust valve to effectuate engine braking, and closing the at least one exhaust valve after predetermined time, wherein said step of opening the at least one exhaust valve to effectuate engine braking during said second compression release event is initiated prior to compression top dead center; and

delaying the opening of at least one intake valve for a predetermined time during engine braking.

In order to satisfy the second step of the recapture rule, the record of the original application must show that the broadening aspect of the reissue claims relates to subject matter that applicant previously surrendered. See M.P.E.P. § 1412.02. No aspect of the reissue Claims 22-50 relates to the subject matter provided by the amendments cited above. Accordingly, Applicants respectfully submit that Claims 22-50 are not an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based. Reconsideration and withdrawal of the rejection are respectfully requested.

**V. 35 U.S.C. 102(b) Rejection**

Claims 22, 25, 26, and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,680,841 to Hu. This rejection is respectfully traversed.

As amended, Claim 22 recites an assembly for operating an engine valve comprising: a rocker shaft; a rocker arm; an hydraulic lash adjuster; an hydraulic passage; and means for (a) supplying hydraulic fluid to the passage during a positive power mode of engine operation and (b) venting hydraulic fluid from the passage during an engine braking mode of engine operation.

Amended Claim 27 recites a method of operating an engine valve lash adjuster comprising the steps of: determining that an engine is operating in positive power mode; supplying hydraulic fluid to a lash adjuster in response to a determination that the engine is operating in positive power mode; determining that the engine is operating in an engine braking mode; and venting hydraulic fluid to the lash adjuster in response to a determination that the engine is operating in braking mode. Although Hu discloses an

internal combustion engine with combined cam and electro-hydraulic engine valve control, Hu does not disclose, teach, or suggest the subject matter claimed in the present application. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

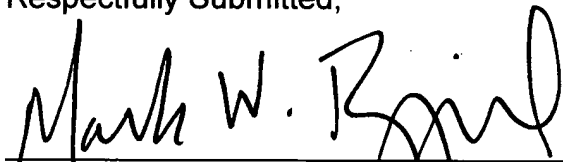
**VI. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully submit that the pending Claims 1-50 of the present reissue application define subject matter patentable over the references cited by the Examiner and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the below listed telephone number.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account contains insufficient funds, the Commissioner is hereby invited to contact Applicants' undersigned representative to arrange payment.

Date: August 22, 2003

Respectfully Submitted,



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### Marked Up Version of the Amended Claims

22. (Amended) An assembly for operating an engine valve comprising:

a rocker shaft;

a rocker arm pivotally mounted on said rocker shaft, said rocker arm including a cavity at a valve actuation end;

an hydraulic lash adjuster slidably disposed in the rocker arm cavity;

an hydraulic passage provided in the rocker arm, said passage communicating with the rocker arm cavity; and

means for (a) supplying hydraulic fluid to the passage during a positive power mode of engine operation and (b) venting [cutting off the supply of] hydraulic fluid from [to] the passage during an engine braking mode of engine operation.

27. (Amended) A method of operating an engine valve lash adjuster in an internal combustion engine comprising the steps of:

determining that an engine is operating in a positive power mode;

supplying hydraulic fluid to a lash adjuster in response to a determination that the engine is operating in a positive power mode of operation;

determining that the engine is operating in an engine braking mode; and

venting [cutting off the supply of] hydraulic fluid from [to] the lash adjuster in response to a determination that the engine is operating in an engine braking mode of operation.